

## **REMARKS**

### **The Amendments**

Claims 1 and 2 are amended to make obvious grammatical corrections. Claim 17 is amended to correct an obvious error in the claim dependency. The amendments do not narrow the broadest scope of the claims and/or are not made for purposes of patentability.

It is submitted that the above amendments would put the application in condition for allowance or materially reduce or simplify the issues for appeal. The amendments do not raise new issues or present new matter and do not present additional claims. The amendments have been made to correct recently noticed obvious errors. Thus, they were not earlier presented. Accordingly, it is submitted that the requested amendments should be entered.

### **The Restriction Requirement**

Applicants maintain their traversal of the restriction requirement. The Final Office Action fails to address applicants' detailed traversal of this requirement. The action only addresses the election of species issue of claims 9, 12 and 13. Thus, the traversal of the restriction requirement is repeated below and applicants urge that it must be given full consideration.

Regarding the restriction of Group II, claims 16-27, from Group I, claims 1-15, applicants' maintain their traversal. The alleged basis for maintaining the requirement in the Office Action does not comply with PTO rules and regulations for requiring restriction. Further, the alleged basis for maintaining the requirement in the Office Action mischaracterizes applicants' prior traversal of the restriction requirement. Applicants' never alleged there was no separate search requirement. But mere separate classification and

further search requirement does not support a restriction requirement. Applicants' arguments were based on failure to establish proper restriction in the instant situation where the claims of Group I and Group II are related as subcombination/combination. These arguments are summarized again, as follows, so that they will be addressed.

The standard for restriction in this case is set forth in MPEP §806.05(c). The non-elected claims 16-27 are directed to compositions, polymers, etc., which contain or are derived from a monomer, oligomer, or polymer of claims 1-15, and some other component. These Group II combinations, as claimed, require the particulars of the subcombination Group. Each of claims 16-27 ultimately depends upon claim 1, and, thus, by definition as dependent claims, they must require the particulars of claim 1. To put it another way, if claim 1 is allowable, claims 16-27 should also be allowable because they contain an embodiment of claim 1 as a component. Accordingly, the first prong of the basis for restriction under MPEP §806.05(c) is not met and the restriction requirement herein is not supported. The current Office Action failed to address these same points made by applicants in the initial response to the restriction requirement. If the restriction is to be maintained, applicants strongly urge that their arguments at least be addressed. Otherwise, the requirement should be withdrawn.

### **The Election of Species Requirement**

In response to applicant's comments on the Election of Species requirement, i.e., that claims 9, 12 and 13 are within the elected species, the Final Office Action apparently disagrees and states that R<sup>4</sup> and R<sup>5</sup> are only optionally P-Sp-. Applicants respectfully point out that

- this statement is incorrect, since claim 9 requires that one or both of R<sup>4</sup> and R<sup>5</sup>

be P-Sp-

- even if the statement was correct, it has no relation to whether claim 9 is within the elected species, and
- the statement has no relation at all to claims 12 and 13.

The elected species is the species of formula Ia of claim 14. This species is defined by the nature of the  $-\text{[(A)}_a\text{-(B)}_b\text{-(C)}_c\text{-(D)}_d\text{]}-$  group. No restriction was made in the elected species as to the  $\text{R}^4$  or  $\text{R}^5$  group. Thus, whether or not the  $\text{R}^4$  and  $\text{R}^5$  groups are P-Sp- has no bearing on whether they are within the elected species. Accordingly, claim 9 encompasses the elected species since it includes species wherein  $-\text{[(A)}_a\text{-(B)}_b\text{-(C)}_c\text{-(D)}_d\text{]}-$  is as defined by formula Ia.

Similarly, regarding claims 12 and 13, these claims do not exclude species wherein  $-\text{[(A)}_a\text{-(B)}_b\text{-(C)}_c\text{-(D)}_d\text{]}-$  is as defined by formula Ia. These claims require species which contain a P-Sp- group somewhere. Although the P-Sp- group could be in the  $\text{R}^1$  or  $\text{R}^2$  group, it is not required to be, for example it can be in the terminal  $\text{R}^4$  or  $\text{R}^5$  groups. In this latter case, the claims encompass species wherein  $-\text{[(A)}_a\text{-(B)}_b\text{-(C)}_c\text{-(D)}_d\text{]}-$  is as defined by formula Ia. Thus, these claims also read on the elected species.

For the above reasons, claims 9, 12 and 13 should be removed from withdrawn status and examined.

#### **The Rejection under 35 U.S.C. §112, first paragraph**

The new rejection of claims 1-6, 10-11 and 14-15 under 35 U.S.C. §112, first paragraph, as failing to have adequate written description in the disclosure is respectfully traversed.

The rejection is made based on allegation of lack of support for the proviso added to claim 1, i.e., "provided that, when b and d are 0 and  $\text{R}^2$  is H,  $\text{R}^1$  is not optionally substituted

aryl or heteroaryl and not -SiR<sup>0</sup>R<sup>00</sup>- substituted alkyl." Applicants had cited, for example, the disclosure at page 14, paragraph [0035], for support of the proviso. This part of the disclosure shows that there was a preference for R1 being alkyl group which is not -SiR<sup>0</sup>R<sup>00</sup>- substituted and is not an aryl group or heteroaryl group. Although the exact words of the proviso are not recited, such is not required for adequate written description under 35 U.S.C. §112, first paragraph. It is well settled that the subject matter of a claim need not be described in the specification literally or "in verbis" in order for the specification to satisfy the description requirement of 35 U.S.C. §112, first paragraph. See In re Lukach, 169 USPQ 795 (CCPA 1971); Kennecott Corp. v. Kyocera International, Inc., 5 USPQ2d 1194, 1197 (Fed. Cir. 1987); Martin v. Johnson, 172 USPQ 391 (CCPA 1972); and In re Wertheim, 191 USPQ 90, at 98 (CCPA 1976). Here, the specification shows a preference towards the compounds to which the claim is more particularly directed by the proviso. The proviso merely provides a way of describing this preference. Although the words of the proviso are not contained in the disclosure, the substance of their meaning is conveyed to one of ordinary skill in the art by the disclosure. This is all that is required for adequate description under 35 U.S.C. §112, first paragraph.

Additionally, even if it is believed that the disclosure does not indicate the preference embodied in the proviso, the prevailing case law supports the acceptability to add provisos limiting the scope of the claims without the need for any specific disclosure of the proviso in the specification; see, e.g., In re Johnson, 194 USPQ 187 (CCPA 1977). The basis for Johnson, which applies here, is that, since the whole scope of the original genus of claim 1 is clearly supported, a scope which only eliminates a small part of such scope by the proviso must also be supported. Clearly, the applicants are not adding any new matter since the proviso makes the claim narrower than previously. In Johnson, the application described a

genus encompassing a large number of species and described a number of specific species. Two of the specifically described species were excluded by proviso. Although there was no description at all in the specification that these two species should be excluded, it was held that the claim reciting the proviso was supported by the disclosure under 35 U.S.C. §112, first paragraph. The facts here are indistinguishable. The genus is clearly supported by the disclosure, a very limited scope of species is excluded by the proviso and that limited scope of species is described in the specification (i.e., the specification describes the embodiments of R<sup>1</sup> being optionally substituted aryl or heteroaryl or -SiR<sup>0</sup>R<sup>00</sup>- substituted alkyl, which are now excluded by the proviso). The following statement by the Court in Johnson fully applies here:

"The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species therewithin, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of those species, and thus has failed to satisfy the requirement of §112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute."

Thus, since the full genus was described and the embodiments which are excluded by the proviso were described as options for R<sup>1</sup>, the specification must support the genus absent such embodiments, i.e., it described all the embodiments as options for R<sup>1</sup>, thus it describes all the embodiments absent the excluded ones. For the reasons supporting the Johnson decision, the proviso recited in claim 1 is not lacking support in the instant disclosure.

For these reasons, the rejection under 35 U.S.C. §112, first paragraph, should be withdrawn.

### **The Rejection under 35 U.S.C. §102**

The rejection of claims 1-6, 10, 11 and 14-15 under 35 U.S.C. §102(b), as being anticipated by Chem Abstract 135:153178 ("Hayashi") or Chem Abstract 130:197214 ("Salzner") is respectfully traversed.

The Final Office Action states that applicants gave no details of why the claims were distinguished from the prior art in their previous traversal of the 35 U.S.C. §102 rejection. To the contrary, applicants clearly pointed out that the compounds disclosed in the references were excluded by the proviso previously added to claim 1 and the definition of R<sup>1</sup> therein. Applicants' arguments appear to have been ignored and, thus, are repeated and expanded on below. The fact that the added proviso is rejected as allegedly lacking support under 35 U.S.C. §112 does not support that the proviso is to be ignored when considering application of prior art to the claims. The 35 U.S.C. §112 and §102 issues are separately considered.

Hayashi discloses phenylacetylene thiophene compounds or polymers having -C≡C-Ph substituents. The monomers, oligomers or polymers of applicants' formula I of claim 1 do not encompass such compounds. Compare the proviso at the end of currently amended claim 1 -- upon which all other claims ultimately depend. The claims exclude compounds and polymers wherein, as the same time, b and d are 0, R<sup>2</sup> is H, and R<sup>1</sup> is optionally substituted aryl or heteroaryl or -SiR<sup>0</sup>R<sup>00</sup>- substituted alkyl. The Hayashi compounds are specifically excluded by the proviso in claim 1. Accordingly, Hayashi does not meet all elements of the claims and cannot anticipate the instant claims under 35 U.S.C. §102.

Salzner discloses thiophene compounds having -C≡C-H substituents. The monomers, oligomers or polymers of applicants' formula I of claim 1 do not encompass such compounds. Compare the definition of R<sup>1</sup> in the currently amended claim 1 -- upon which all other claims

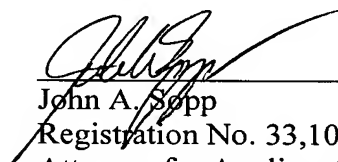
ultimately depend. Salzner fails to disclose compounds or polymer having a thiophene ring with a  $-C\equiv C-R^1$  substituent wherein  $R^1$  is not hydrogen. Thus, Salzner does not meet all elements of the claims and cannot anticipate the instant claims under 35 U.S.C. §102.

For the above reasons, it is urged that the rejection of the claims under 35 U.S.C. §102(b) should be withdrawn. Further, the Hayashi and Salzner references would not support a rejection under 35 U.S.C. §103. The abstracts indicate no utility for the compounds disclosed therein. Where a reference discloses no utility for compounds disclosed therein, the reference provides no motivation to one of ordinary skill in the art to modify such compounds even to compounds which are allegedly structurally similar. In re Stemniski, 170 USPQ 343 (CCPA 1971).

It is submitted that the application is in condition for allowance. But the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

  
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